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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1947.

No. 399

NATIONAL PRESSURE COOKER COMPANY,
a corporation,
Petitioner,

vs.

ALUMINUM GOODS MANUFACTURING COMPANY,
a corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner respectfully prays that the writ of certiorari issue to the United States Circuit Court of Appeals for the Seventh Circuit to review a judgment of that Court entered in this case on April 19, 1947 (R. p. 373), reversing a judgment of the United States District Court for the Northern District of Illinois, Eastern Division.

A petition for rehearing (R. p. 375) was filed in the Circuit Court of Appeals for the Seventh Circuit on May 5, 1947, and denied on July 16, 1947 (R. p. 397).

A certified transcript of the record in this case, including the proceedings in and the opinion of the said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

I.

SUMMARY STATEMENT OF MATTERS INVOLVED.

(A) Jurisdictional Statement.

Jurisdiction is invoked under Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended, and Rule 38 (5) (b) of the Supreme Court of the United States. The decree to be reviewed was entered on April 19, 1947 (R. p. 373). A petition for rehearing was filed on May 5, 1947 and denied on July 16, 1947 (R. p. 397).

(B) Nature of Action and Summary of Facts.

This is an action for patent infringement, brought by Petitioner in the United States District Court for the Northern District of Illinois, Eastern Division, to enjoin infringement of the Wittenberg patent No. 2,218,188 (R. p. 250), entitled "Pressure Cooker", which issued to Petitioner October 15, 1940.

Respondent counter-claimed, alleging that all the claims were invalid, but if valid were not infringed. The Trial Court held claims 1 and 2 valid and infringed, claims 3, 4 and 5 invalid and claim 6 valid but not infringed. (Letter of opinion, R. p. 226, Findings of Fact and Conclusions of Law, R. p. 231 and Judgment R. p. 235).

From this judgment, holding claims 1 and 2 valid and infringed and claim 6 valid, Respondent appealed to the Circuit Court of Appeals for the Seventh Circuit. The Circuit Court of Appeals in a judgment entered on April

19, 1947 (R. p. 235), reversed the District Court and held claims 1, 2 and 6 invalid for want of invention. A petition for rehearing was denied by the Circuit Court on July 16, 1947 (R. p. 397).

Briefly stated, the record shows the defendant urged lack of invention over some twenty-five paper patents, no one of which was shown ever to have been used. The plaintiff urged that invention was shown by the great improvement in the practical art, in view of the admitted facts that while each element of the combination claims was old, the combination was new. It plainly appears that prior art cookers were not satisfactory, that plaintiff's employees over a period of years made many efforts to improve its product and that it was on the coming of the Wittenberg invention that the problems of safety, convenience and cost were solved. The evidence showed that the defendant twice was urged to make prior art pressure cookers. It did not do so. The Wittenberg pressure cookers came on the market in November, 1939. This provoked Respondent's interest. It then came into the field with the accused cookers.

The Trial Court found (R. pp. 232-233) that Wittenberg pressure cookers had a greater utility, simplicity, safety and economy than existed in the prior art. It found that Wittenberg produced a "new result." In pursuit of these findings and the proof of immediate public acceptance of the Wittenberg cookers, the Trial Court held claims 1, 2 and 6 valid.

The Circuit Court of Appeals expressly agreed that the Wittenberg pressure cooker "possessed a greater utility than any of its predecessors, it was safer, simpler and easier to operate, cost less to manufacture and required less expense for repairs and servicing" (R. p. 366). However, the Circuit Court of Appeals did not agree with the

Trial Court's finding that a "new result" had been produced, because prior art pressure cookers had cooked foods. Further, the Circuit Court of Appeals found that in the course of prosecution in the Patent Office, the claims had been amended, and judged the invention, not by comparing the combination claims, as allowed, with the prior art, but by comparing the claims as amended with the claims prior to amendment. On the basis of its own finding, contrary to the finding of the Trial Court, that there was no "new result," and on the basis of its postulate that a rejected application claim—not prior art in fact—*ipso facto* became prior art when amended, the Circuit Court of Appeals found no invention.

(C) Questions Presented.

1. Has the Circuit Court of Appeals for the Seventh Circuit applied a new requirement in holding that a patent on a cooking utensil to be valid must, in addition to producing a "new result" in a cooking utensil, produce a "new result" on the unpatented food with which its use is contemplated?

2. Has the Circuit Court of Appeals for the Seventh Circuit, in disregarding the fact finding by the Trial Court that the patent in suit secured a "new result," departed from Rule 52 (a) of the Federal Rules of Civil Procedure?

3. Has the Circuit Court of Appeals for the Seventh Circuit applied an erroneous postulate that a claim in a patent application, not itself prior art, becomes such if the applicant amends it?

(D) Reasons Relied On for the Allowance of the Writ.

1. The Circuit Court of Appeals below has decided important questions of Federal Law in a way probably in conflict with the applicable decisions of this Court.

While expressly finding that cookers made under the patent in suit had a greater utility than any of its predecessors, were safer, simpler, easier to operate, cost less to manufacture and required less expense for repairs and servicing, the Circuit Court of Appeals found that no "new result" was produced. In *Webster Loom Company* v. *Higgins*, 105 U. S. 580, 591, 592, 26 L. Ed. 1177 (1882) this Court in its opinion by Mr. Justice Bradley stated:

> "* * * It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty. * * *"

In subsequent decisions this Court has uniformly given a similar interpretation to the words "new result."

2. The Circuit Court of Appeals below has decided an important question of Federal Law in a way probably in conflict with the applicable decisions of this Court and of other Circuit Courts of Appeal and also in conflict with Rule 52 (a) of the Rules of Civil Procedure.

The Circuit Court of Appeals set aside the findings of the Trial Court that Wittenberg secured a "new result," and made an invention without considering whether the findings were "clearly erroneous." While this Court has not passed upon the question since the adoption of the Rules of Civil Procedure, its former decisions and decisions of other Circuit Courts of Appeal are contrary to the decision below.

3. The Circuit Court of Appeals below has decided an important question of Federal Law in conflict with deci-

sions of other Circuit Courts of Appeal, which question has not been, but should be, settled by this Court.

This Court has never considered significant an amendment of a claim in a patent application, except on the issue of *infringement*. The Circuit Courts of Appeal for the Second and Sixth Circuits have each declined to consider such an amendment on the issue of *validity*, holding that the claim finally allowed should be judged on the prior art as it existed in fact. The Circuit Court of Appeals below has held that a claim must show invention over the prior art as it existed in fact, and also, in the event that it was amended during prosecution, over the claim as it read prior to amendment.

WHEREFORE, it is respectfully submitted that this petition for a writ of certiorari to review the judgment of the Circuit Court of Appeals for the Seventh Circuit should be granted.

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE CIRCUIT COURT OF APPEALS APPLIED A NEW REQUIREMENT FOR PATENTABILITY IN CONFLICT WITH APPLICABLE DECISIONS OF THIS COURT.

The Trial Court found that the Wittenberg patent secured a new result and was an invention. The Circuit Court of Appeals reversed these findings on the basis of its limiting the meaning of "new result" far beyond its reasonable limits, and in conflict with applicable decisions of this Court. The Circuit Court of Appeals said in its opinion (R. p. 366):

> "* * * Certainly the record discloses that plaintiff's cooker manufactured under the patent in suit possessed a greater utility than any of its predecessors, it was safer, simpler and easier to operate, cost less to manufacture and required less expense for repairs and servicing. We are of the opinion, however, that the record fails to support the finding that a 'new result' was produced. In fact, we think that such was not the case. The purpose to be served by any pressure cooker is to transform raw foods into those fit and proper for human consumption. We find nothing in the record to indicate but that this result was satisfactorily obtained by cookers in existence and use at the time of plaintiff's claimed invention."

In this, the Circuit Court of Appeals held that if the broad purpose of a patented device has been served by a prior art device, no "new result" can be secured—regardless of increased utility, safety, convenience and economy. This Court has held to the contrary.

The leading case in which this Court sustained a patent because it secured a "new result" is *Loom Co.* v. *Higgins*,

105 U. S. 580 (1881). In that case, this Court in its opinion by Mr. Justice Bradley indicated clearly that the "new result" which will sustain a patent is a "new result" in the sense of an "improved result", at pages 591 and 592 as follows:

> "* * * *It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty;* and we think that the combination of elements by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent." (Emphasis supplied.)

More recently this Court in *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364 (1942) held that a greater adjustability in a shoe lasting machine was a new result. In its opinion by Mr. Justice Roberts this Court used the words "improved result" and "new result" as synonomous at page 367:

> "* * * These findings are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way so as to produce an improved result. These are findings of fact, despite the petitioner's apparent contention to the contrary, and we will not disturb such concurrent findings where, as here, there is evidence to support them. The claim that the combinations are merely of old elements, which perform no new function and produce no new result, must be overruled."

There are many other decisions of this Court with which the decision of the Circuit Court of Appeals herein is in conflict. Among them is *Abercrombie & Fitch Co.* v. *Baldwin*, 245 U. S. 198 (1917) in which this Court held valid and infringed a patent on a carbide lamp. It might have been said that the purpose to be served by any carbide lamp is to transform chemicals into light. Such result was old. Carbide lamps were old. But this Court sustained the patent,

expressly approving the decision of the District Court in which safety and simplicity of construction and operation were stated to be "controlling considerations."

In *Hildreth* v. *Mastoras,* 257 U. S. 27 (1921) this Court held valid and infringed a patent on a candy pulling machine. The purpose to be served by any candy machine is to transform sugar and other materials into candy. This result was old. But this Court sustained the patent because of increased sanitation, and reduced cost. The Circuit Court of Appeals herein while conceding the contributions of increased safety, utility, convenience, and economy, denied patentability to Wittenberg because Wittenberg was not the first to cook food.

The Patent Act expressly provides for the patentability of "improvements" (U. S. Code, Title 35, Sec. 31). The test applied by the Circuit Court of Appeals would deny patentability to any improvement on the ground of a "new result". The applicable decisions of this Court are to the contrary.

THE ACTION OF THE CIRCUIT COURT OF APPEALS IN REJECTING THE FINDINGS OF THE TRIAL COURT IS IN CONFLICT WITH DECISIONS OF THIS COURT AND OTHER CIRCUIT COURTS OF APPEAL AND IS ALSO IN CONFLICT WITH RULE 52(a) OF THE FEDERAL RULES OF CIVIL PROCEDURE.

Rule 52(a) of The Rules of Civil Procedure provides:

> "* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses * * *."

This rule preserves the same distinction in function between trial court and court of review which have existed for many years. This court in its opinion by Mr. Justice Shiras in *Dooley* v. *Pease,* 180 U. S. 126, 131-132, 45 L. Ed. 457 (1901) stated the rule:

"Where a case is tried by a court, a jury having been waived, its findings upon questions of fact are conclusive in the courts of review, it matters not how convincing the argument that upon the evidence the findings should have been different * * *."

"Errors alleged in the findings of the court are not subject to revision by the Circuit Court of Appeals, nor by this court, if there was any evidence upon which such findings could be made * * *."

More recently, this Court in its opinion by Mr. Justice Murphy said in *Lavender* v. *Kurn*, 327 U. S. 645, 653, 90 L. Ed. 916 (1946):

"It is no answer to say that the jury's verdict involved speculation and conjecture. Whenever facts are in dispute or the evidence is such that fair-minded men may draw different inferences, a measure of speculation and conjecture is required on the part of those whose duty it is to settle the dispute by choosing what seems to them to be the most reasonable inference. *Only when there is a complete absence of probative facts to support the conclusion reached does a reversible error appear.* But where, as here, there is an evidentiary basis for the jury's verdict, the jury is free to discard or disbelieve whatever facts are inconsistent with its conclusion. *And the appellate court's function is exhausted when that evidentiary basis becomes apparent, it being immaterial that the court might draw a contrary inference or feel that another conclusion is more reasonable.*" (Emphasis supplied.)

The Trial Court below found that Wittenberg produced a "new result" and that his contribution to the art constituted an invention. Both of these findings are findings of fact. *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367, 86 L. Ed. 1537 (1942); *United States* v. *Esnault-Pelterie*, 299 U. S. 201, 81 L. Ed. 123 (1936), 303 U. S. 26, 82 L. Ed. 625 (1938). The Circuit Court of Appeals reversed both of these findings on the ground, as the court expressed it, "we think" the con-

trary. This decision of the Circuit Court of Appeals reversing the District Court on questions of fact is clearly contrary to the Federal Rules of Civil Procedure and is in conflict with the decisions of this Court referred to above. Moreover, this decision is in conflict with decisions of other Circuit Courts of Appeal.

In *Arnstein* v. *Porter*, 154 Fed. (2d) 464, 474 (1946) the Circuit Court of Appeals for the Second Circuit reviewed a judgment in a copyright case. The Court, in its opinion by Judge Frank, said as to the relative spheres of the trial court and the court of review:

> "* * * Where the facts are thus in real dispute, it is our function, after a trial in the lower court, to review its legal conclusions and, with reference to its findings of fact, to determine not whether we would ourselves have made them, but merely whether they rest on sufficient evidence in the record. When the trial occurs before a judge without a jury, we have his findings of fact separated from his legal conclusions; when it occurs before a jury, our task is somewhat different, especially when the jury returns a general (i. e., composite) verdict. But in reviewing a judgment after either type of trial, ours must be a limited function. This is not, and must not be, a trial court. Such a court has a duty more difficult and important than ours. We begin our task where it leaves off."

In *Lincoln Stores, Inc.* v. *Nashua Manufacturing Co.*, 157 F. (2d) 154 (1946), the Circuit Court of Appeals for the First Circuit affirmed a judgment, in part, of validity and infringement. The Court, in its opinion by Judge Mahoney, called attention to the rule that the question of invention is one of fact and continued in its opinion at p. 163:

> "* * * The presumption of the validity of Amory's patent arising from its issuance, *Mumm* v. *Jacob E. Decker & Sons*, 1937, 301 U. S. 168, 171, 57 S. Ct. 675, 81 L. Ed. 983, taken together with the many years of effort to produce what Amory produced and its sub-

stantial commercial success, makes it impossible for us to say that the district court was clearly erroneous in deciding that Amory had produced a patentable invention. Rule 52(a), F.R.C.P., 28 U.S.C.A. following section 723c".

The decision of the Circuit Court of Appeals below is clearly in conflict with the decision of the Circuit Court of Appeals for the First Circuit in *Lincoln Stores* v. *Nashua Manufacturing Co., supra.* The Circuit Court of Appeals below did not state as did the Circuit Court of Appeals for the First Circuit that the presumption of validity taken together with the years of effort to produce what Wittenberg produced and its substantial commercial success "makes it impossible for us to say that the District Court was clearly erroneous." The Circuit Court of Appeals below reversed saying, "we think" differently from what the Trial Court thought.

Attention is also directed to *Hazeltine Corporation* v. *General Motors Corporation*, 131 Fed. (2d) 34 (1942) in which the Circuit Court of Appeals for the Third Circuit affirmed a judgment for the defendant in a patent case. The Court pointed out in its opinion by Judge Goodrich that the question of invention is one of fact and the Trial Court's finding that the patent lacked invention was "supportable in view of the evidence." It is evident that the Circuit Court of Appeals below did not confine its inquiry to the proper functions of a court of review, to-wit, determining whether or not the fact findings of the Trial Court were "supportable in view of the evidence."

The proper interpretation to be given to Rule 52a of the Federal Rules of Civil Procedure is a matter of great importance to litigants. The numerous petitions for certiorari which, in the last term of this Court, have been filed in an effort to get this Court to pass upon the question bear

witness to the importance of the question.* Although the lower courts have repeatedly discussed Rule 52a, this Court has not interpreted the rule and its key words "clearly erroneous." Does the rule require affirmance, even though the Circuit Court of Appeals might have found differently had it been the trier of fact, so long as there is some evidence to support the findings? Such was the opinion of the Circuit Courts of Appeal in the decision just discussed. Or does Rule 52a give the Circuit Court of Appeals latitude to reverse in any case in which it would have found the facts differently? Such was the action of the Circuit Court of Appeals below.

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* Docket No. 121. *Dieckhaus* v. *Twentieth Century Fox Film Corporation* (153 F. (2d) 893, CCA 8, 1946) No. 1260 Oct. Term, 1945, Cert. Denied October 14, 1946, 329 U. S. 716, 91 L. Ed. 37.

Docket No. 128. *Liberty Mutual Ins. Co.* v. *Pillsbury*, (154 F. (2d) 559, CCA 9, 1946) No. 1272 Oct. Term 1945, Cert. Denied Oct. 14, 1946, 329 U. S. 717, 91 L. Ed. 38.

Docket No. 158. *J. E. Haddock, Ltd.* v. *Pillsbury*, (154 F. (2d) 1018, CCA 9, 1946) Cert. Den. Oct. 14, 1946, 329 U. S. 729, 91 L. Ed. 39, Rehearing Denied 11-12-46, ... U. S. ..., 91 L. Ed. 84.

Docket No. 321. *Chatz* v. *Armour Plant Employees Credit Union*, (154 F. (2d) 236, CCA 7, 1946) Cert. Den. 10-14-46, 329 U. S. 728, 91 L. Ed. 42, Rehearing Denied 11-12-46, 329 U. S. 827, 91 L. Ed. 85.

Docket No. 322. *Chatz* v. *Todd*, (154 F. (2d) 236, CCA 7, 1946) (Consolidated with 321) Cert. Den. 10-14-46, 329 U. S. 728, 91 L. Ed. 42, Rehearing Denied 11-12-46, 329 U. S. 827, 91 L. Ed. 85.

Docket No. 438. *Harris-Stanley Coal & Land Co.* v. *Chesapeake & Ohio R. R. Co.*, (154 Fed (2d) 450, CCA 6, 1946) Cert. Den. 10-21-46, 329 U. S. 761, 91 L. Ed. 64.

Docket No. 527. *Lorraine Coffee Company, Inc. et al.* v. *LaTouraine Coffee Co., Inc.*, (157 F. (2d) 115, CCA 2, 1946) Cert. Den. 11-12-46, 329 U. S. 771, 91 L. Ed. 75.

Docket No. 560. *Dixi-Cola Laboratories, Inc. et al.* v. *Coca-Cola Company*, (155 F. (2d) 59, CCA 4, 1946) Cert. Den. 11-12-46, 329 U. S. 773, 91 L. Ed. 75.

Docket No. 561. *Coca-Cola Company* v. *Dixi-Cola Laboratories, Inc. et al.*, (155 F. (2d) 59, CCA 4, 1946) Cert. Den. 11-12-46, 329 U. S. 773, 91 L. Ed. 75.

Docket No. 660. *Union Producing Co.* v. *White et al.*, (157 F. (2d) 254, CCA 5, 1946) Cert. Den. 12-16-46, 329 U. S. 792, 91 L. Ed. 241.

Docket No. 700. *Borg-Warner Corp. et al.*, v. *Goodwin et al.*, (157 F. (2d) 267, CCA: 6, 1946) Cert. Den. 1-6-47, 329 U. S. 799, 91 L. Ed. 373, Rehearing Denied 2-3-47, 329 U. S. 835, 91 L. Ed. 555, Second Pet. for Rehearing Denied 6-23-47, ... U. S. ..., 91 L. Ed. 1607.

Docket No. 740. *The Foxboro Company* v. *Taylor Instrument Companies*, (157 F (2d) 226, CCA 2, 1946) Cert. Den. 1-6-47, 329 U. S. 800, 91 L. Ed. 374.

Docket No. 976. *Royal Packing Co.* v. *Porter*, (157 F. (2d) 524, CCA 8, 1946) Cert. Den. 3-17-47, ... U. S. ..., 91 L. Ed. 790.

THE CIRCUIT COURT OF APPEALS DREW IMPROPER CONCLUSIONS FROM THE PATENT OFFICE HISTORY IN CONFLICT WITH DECISIONS OF OTHER CIRCUIT COURTS OF APPEALS.

In its opinion the Circuit Court of Appeals below discussed the Patent Office history of the Wittenberg patent application and applied it in a manner which is unwarranted in law or fact and in conflict with decisions of other Circuit Courts of Appeal. The Court below stated in its opinion (R. p. 371):

> "* * * There is some confusion in the authorities as to the importance which may properly be attached to an amendment by which the allowance of a patent has been procured."

What the Circuit Court of Appeals referred to as "confusion in the authorities" might more properly be expressed as "conflict of authorities," a conflict between the decision below and decisions of other Circuit Courts of Appeal.

The question presented has never been discussed by this Court and has never been decided—save in the sense that on a similar record this Court has never applied the reasoning applied by the Court below. The question has been passed upon by the Circuit Courts of Appeal of the Second and Sixth Circuits, with whose decisions the decision below is in conflict.

In the prosecution of a patent application, involving patentable subject matter, the principal effort of the applicant and the Patent Office examiner is to arrive at the proper definition, in the claim, of the invention. Due at times to lack of complete knowledge of the prior art in advance of application, and due also to the limitations of language, the applicant frequently is required to amend

his claims. The question here presented is the significance of such amendments when considering *validity* in an infringement suit.

The significance of an amendment when considering the issue of *infringement,* has been discussed by this Court in numerous decisions. When applying a claim to an alleged infringement, matter added to the claim by amendment to avoid the prior art is strictly construed. This is the commonly termed "file wrapper estoppel." (*Exhibit Supply Co.* v. *Ace Patents Corporation,* 315 U. S. 126, 86 L. Ed. 736 (1942); *Keystone Driller Company* v. *Northwest Engineering Corp. et al,* 294 U. S. 42, 79 L. Ed. 747 (1935).

Although this Court has frequently applied the "file wrapper estoppel" doctrine on the issue of *infringement,* it has never applied any estoppel on the issue of *validity.* The reasons are fundamentally that a claim should be measured by the prior art as it existed *in fact,* and there is no basis in logic or justice for establishing any synthetic "prior art" by an alleged estoppel.

The Court below quoted with approval from one of its previous decisions which announced a rule that invention may be judged on the basis of the last amendment in the Patent Office. The reasoning was: the claim prior to amendment was not allowed, so without amendment there was no invention; the only question is, therefore, as to whether the last amendment gave patentability to what was not otherwise patentable. This reasoning overlooks the realities of Patent Office practice. The gist of the invention is ordinarily embodied in the claim as originally filed, but may be imperfectly or inaccurately expressed. The claim which is finally allowed should be judged in its final form, and compared with the prior art *as it existed in fact.* The reasoning of the Court below sets up a pseudo or synthetic

prior art, by treating a claim prior to amendment as though it were prior art. Other Circuit Courts of Appeal have held to the contrary.

In *International Cellucotton Products Co.* v. *Sterilek Co., Inc.*, 94 F. (2d) 10 (1938), the Circuit Court of Appeals of the Second Circuit passed upon a similar question. Sufficient of the facts and the decision by the Circuit Court of Appeals for the Second Circuit appear in a portion of the opinion of that Court by Judge Learned Hand at p. 12:

> "* * * However, the examiner cited against these claims, as well as against claim 19 the 'Johnson & Johnson machine,' which we have just mentioned, but about whose structure the file-wrapper tells very little. To escape this reference Bauer limited the claims in suit to a machine in which the gauze ran at right angles to the filler web, just as he introduced into claim 19, the other clause just considered. The defendant bases its case very largely on the assumption that by so doing he conceded that the prior art anticipated the claims except for this interpolated feature. This has been sometimes said in the case of disclaimers, which are in substance limitations imposed after issue; but it is a mistaken view of the law. When an inventor consents to limit his monopoly, there is no reason in fact to impute to him the belief that his only patentable advance lies in the element so introduced. He may merely think that he still retains enough for practical purposes, and that the examiner's insistence does not justify the expense of an appeal. Nor is there any reason to impose upon him the same consequence as though he had formally so conceded; it is enough that he has freed the art except as the claim reads, and that he has surrendered any power under the doctrine of equivalents to resume what he has given up. He has done nothing which need prevent him from insisting in support of the claim as allowed that his invention was broader than the examiner supposed; he is not confined to the examiner's reasoning, or committed to his mental processes. *United Chromium* v. *International Silver Co.*, 2 Cir., 60 F. 2nd 913, 915."

See also *Katz* v. *Horni Signal Manufacturing Corp.*, 145 F. (2nd) 961 (CCA 2, 1944) in which the Court pointed out that the use of the file wrapper is restricted to questions of infringement and as to whether a patentee who seeks to disavow an element in the claim was forced to introduce it in order to avoid rejection. The decision of the Circuit Court of Appeals below is in conflict with these two decisions, as well as many others of the Circuit Court of Appeals of the Second Circuit. In the Second Circuit a file wrapper may be used only on the question of infringement and only when there is a strict file wrapper estoppel. The decisions of this Court, likewise, have gone no farther in the use of the file wrapper than to permit its use where there is an amendment and a strict estoppel. The use made of the file wrapper in this Court has likewise been on the issue of infringement. The decision of the Circuit Court of Appeals below is clearly in conflict.

The decision of the Court below is also in conflict with *W. S. Godwin Co.* v. *International Steel Tie Co.*, 2 F. (2d) 198 (1924) in which the Circuit Court of Appeals for the Sixth Circuit considered the proper use of the file wrapper. In its opinion by Judge Denison the Circuit Court of Appeals for the Sixth Circuit, at p. 199 said:

> "In its progress through the Patent Office claim 4, with others, was rejected on reference to Freese. It was thereupon amended to include the guard limitation finally found in it, 'extending to the upper edge of the roadway and forming a boundary therefor,' and it was pointed out that the application was distinguished from Freese by this additional limitation. It is said that since there was no invention in this mere limitation or modification, and that since the applicant rested his case thereon, he cannot now be heard to say that invention may be found elsewhere in, or in connection with, the device."

"The familiar rule of estoppel by Patent Office proceedings is invoked. This rule does not reach the case. The patentee may not later have such a construction of his claim that it will cover the device which has been thus protected by his confession and avoidance; but so long as he does not seek thus to broaden his claim, we do not know of any principle or authority which would bar him from claiming that his device was in fact patentable for other reasons than the one shown by his amendment. The conclusion of the Examiner to grant a particular claim, like the conclusion of an equity trial court to enter a particular decree, will be approved, if it was right, although the reason given is not sound. See *Campbell Co.* v. *Pomeroy Co.* (D.C., 300 F. 872, 873, Learned Hand, D. J."

The error of the Court below in its use of the file wrapper also appears from a consideration of the final amendment which is discussed by the Court below. Before the last amendment, three claims were rejected as unpatentable over a combination of three different patents (R. p. 209). In the final amendment words were added which required that the cams of the pressure cooker be concealed when the cover was on the body of the cooker, and in one instance that there be an unbroken circumferential line between the cover and body. A reference to this amendment was made in the remarks of the patent solicitor as pointed out by the Court below. However, the major portion of the remarks accompanying the amendment as appears in R. pp. 211 to 213 are directed to the proposition that as a matter of law the Examiner was in error in rejecting on the three references and further to showing that even if the three references were combined they would not produce Wittenberg's structure. Thus, final allowance came after argument, first, that the previous rejection on a combination of three references was improper on the basis of the authorities; second, that the rejection was improper because in

fact the three references could not be combined and their alleged combination would not produce the structure of Wittenberg; third, there were amendments made as to the concealment of the cams, etc. The file wrapper does not show which of these three approaches secured the allowance of the claims. The Circuit Court of Appeals below has assumed, first, that allowance was secured merely by the amendment to the claim that the persuasive arguments made by the applicant, quite apart from the amendment, were of no significance. This assumption is unwarranted. Further, the Circuit Court of Appeals has assumed that the claims before amendment defined the prior art. This assumption likewise is not warranted and is directly contrary to the decisions of the Circuit Courts of Appeals of the Second and Sixth Circuits to which reference has been made. As was pointed out by the Circuit Court of Appeals for the Sixth Circuit in Judge Denison's opinion, the rule of file wrapper estoppel "does not reach the case" and further "we do not know of any principle or authority which would bar him from claiming that his device was in fact patentable for other reasons than the one shown by his amendment." In the case at bar, three reasons for patentability were urged in the last amendment. The Circuit Court of Appeals for the Sixth Circuit would consider any one of those three reasons, plus any other reasons which might be urged for patentability. The Court below seized upon one only, and finding it inadequate, held the patent invalid.

The conflict with the opinion of the Circuit Court of Appeals for the Second Circuit in *International Cellucotton Products Co.* v. *Sterilek Co., Inc., supra,* is likewise clear. That court in its opinion by Judge Learned Hand applied the rule that "there is no reason in fact to impute to him

the belief that his only patentable advance lies in the elements so introduced" by amendment. A reading of the entire file wrapper of the Wittenberg patent shows that the patent owner desired issuance at as early a date as possible. An affidavit was filed to make the case special (R. p. 181). The subsequent infringement by the defendant and others (R. p. 70-71) justify the haste of the patent owner. Under these circumstances with the claims standing rejected, the owner of the Wittenberg patent was justified in thinking that the claims, even with amendment, would be enough for practical purposes and that there was not justification for the time and expense of an appeal.

It is respectfully submitted that this Court should pass upon the question as to the significance which may be properly attached to an amendment prior to final allowance of a claim.

As pointed out in the opinion of the Court below, there is "some confusion in the authorities"—i. e. conflict—as to this point. This Court has never expressly passed on the question, having limited its consideration of the file wrapper to questions of infringement.

Conclusion.

For the foregoing reasons, it is respectfully submitted that this petition should be allowed and the judgment of the Circuit Court of Appeals for the Seventh Circuit reviewed and reversed.

Respectfully submitted,

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1947

No. 399

NATIONAL PRESSURE COOKER COMPANY,
a corporation,

Petitioner,

vs.

ALUMINUM GOODS MANUFACTURING COMPANY,
a corporation,

Respondent.

REPLY BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

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THE TWENTIETH CENTURY PRESS, INC., CHICAGO

IN THE

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OCTOBER TERM, A. D. 1947

No. 399

NATIONAL PRESSURE COOKER COMPANY,
a corporation,

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Respondent.

REPLY BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I

Respondent's Brief (pp. 3 and 4) argues that there is no conflict between the decision below as to the requirement of a "new result" and decisions of this Court, and further that the question is moot because not necessary to the decision below. At no place in its brief does respondent refer to the specific question presented (Petition p. 4). Respondent has not denied that the Circuit Court of Appeals below has required that there not only be a "new result" in the patented cooking utensil, itself, but also a "new result" in the unpatented food.

The statement by the respondent (Br. p. 4) that the Court below found the Wittenberg patent "anticipated by the prior art" and consequently that the question of a "new result" is a moot question, is in error. The Court below held claims 1, 2 and 6 "invalid for lack of invention" (R. p. 372). In reaching this decision, the Court necessarily considered of significance whether or not a "new result" was produced. It is to be observed that in summarizing the principles of law, the Court stated (R. p. 369):

> "an improvement or advantage resulting from a combination of old elements, *especially where no new result is obtained,* is ordinarily credited to mechanical skill rather than invention." (Emphasis supplied).

II

With respect to the second question presented, the respondent argues (Br. pp. 5-12) that the question of invention may be a question of law and that the Circuit Court of Appeals did not find as to facts any differently from the Trial Court. The opinion (R. p. 366) shows that the Circuit Court of Appeals specifically rejected a fact finding of the Trial Court.

In so far as the applicability of Rule 52(a) of the Rules of Civil Procedure is concerned, it makes no difference, as respondent suggests (Br. p. 6), whether the facts found by the Trial Court be details or ultimate facts. The notes of the Advisory Committee as to Rule 52(a) state as to the specific sentence of the rule which is here involved:

> "It is applicable to all classes of findings in cases tried without a jury whether the finding is of a fact concerning which there was conflict of testimony, or of a fact deduced or inferred from uncontradicted testimony."

III.

Respondent's Brief (pp. 12-15) argues as to the third question presented that the Circuit Court of Appeals did not rely upon the file wrapper. At p. 14 of its brief, respondent states that the opinion of the Circuit Court of Appeals "is based solely" upon consideration of the prior art.

Four pages of the nine-page opinion of the Court below deal with the file wrapper. The Circuit Court of Appeals did "consider" the file wrapper. The Court also called attention to the "confusion in the authorities" which is, in fact, an irreconcilable conflict which has never been passed upon by this Court. This conflict is not denied by respondent.

The Circuit Court of Appeals in the instant case relied upon its own previous decision in *Electro-line Co.* v. *Reliable Electric Co.*, 101 F. (2d) 380, a decision not reviewed by this Court. In the *Electro-line Case* it was stated that in an infringement suit the Court had "no right" to rule differently from the ruling of the Patent Office. This is in plain conflict with the decisions of the Circuit Courts of Appeal of the Second and Sixth Circuits, as pointed out in petitioner's original brief.

At pp. 1 and 2 of its brief, the respondent calls attention to decisions which show that this Court does not grant certiorari in "an ordinary case." The question, as to the effect to be given to an amendment made in the course of the prosecution of a patent application in an infringement suit after the patent is issued, is a question which has never been passed upon by this Court. The decision below and the previous decision of the same Court relied upon are in clear conflict with decisions of other Circuit Courts of Appeal. The question is one of importance to litigants

and potential litigants in patent infringement cases. It is a question of importance to any applicant for a patent. It is respectfully submitted that it is a question of public importance in which there is "a real and embarrassing conflict of opinion" between the Circuit Courts of Appeal, and which should be decided by this Court.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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PETITION SETS FORTH NO ADEQUATE REASON FOR GRANTING WRIT.

"This is an ordinary patent case." This sentence is the opening sentence of the decision of this court in the case of *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.,* 261 U. S. 387, 388. The decision goes on to state the conditions upon which this court should grant a writ of certiorari. This is on page 393 where the court states:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases

involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

his court further emphasized these two conditions in its cision in *Magnum Import Co., Inc.* v. *Coty*, 262 U. S. 9, 163, where it also stated:

"The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

In the instant case, neither of the two requisite conditions to the granting of petitions for writs of certiorari present. The decision which petitioner seeks to have viewed is not in conflict with any decision of any other ircuit Court of Appeals, and no question of public importance is involved.

Nor does the petition present "special and important easons," as required by Rule 38 (5) of the rules of this ourt.

This is an ordinary patent suit and the only question nvolved is as to the validity of claims 1, 2 and 6 of the Vittenberg Letters Patent No. 2,218,188. The following statement of this court in *Keller* v. *Adams-Campbell o.*, 264 U. S. 314, 317, therefore is controlling:

"Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile the decisions of circuit courts of appeal on the same patent."

Reasons Relied Upon by Petitioner Insufficient To Entitle It to a Writ of Certiorari.

The several reasons upon which the petition is based will be considered briefly in the order in which they appear in the petition.

I.

The first of the three reasons relied on by petitioner for the allowance of the writ is based on an allegation that the Circuit Court of Appeals erred in finding that no "new result was produced." This position appears to be merely a quibble over the meaning of the words "new result." The Circuit Court of Appeals agreed in its opinion with the findings of fact of the District Court that "the patent in suit possessed a greater utility than any of its predecessors, it was safer, simpler and easier to operate, cost less to manufacture and required less expense for repairs and servicing." Consequently, as to these findings of fact, the Circuit Court of Appeals agreed with the District Court. It disagreed, however, with the District Court in that court's finding that a "new result" was produced. The Court of Appeals stated that there was nothing in the record to show that the Wittenberg pressure cooker performed any differently as a pressure cooker in its operation upon the food therein than did any of the prior art pressure cookers. This statement of the Circuit Court of Appeals is clearly supported by the record and is correct. It does not conflict with any applicable decisions of this court.

The petitioner cites, in support of its argument, the old and well-known case decided by this court in 1881, *Loom Co* v. *Higgins,* 105 U. S. 580. In that case a loom was held

patentable on the basis that it achieved a "new result" by producing fifty yards a day when prior looms had never produced more than forty yards a day. It is not apparent how that decision has any application to the present case. There is no showing whatever in this case that the Wittenberg pressure cooker cooked any more food in a given period of time or cooked it more efficiently than prior art cookers. It did not produce fifty pounds of food where other cookers had never produced more than forty, nor did it produce food which was better cooked.

The petitioner also refers to the decision of this court in *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, and alleges that a decision there used the words "improved result" and "new result" as synonymous. In that case, again, the subject matter of the patent was a machine for producing a product. The court held that it did produce the product more efficiently and, on that basis, affirmed the concurrent holdings of the District Court and Circuit Court of Appeals.

It is important to point out that there are no concurrent decisions in the present case. While the Circuit Court of Appeals did not disturb the findings of fact of the District Court, it did draw a definite and opposite conclusion from those facts. It, therefore, reversed the decision of the District Court.

The statement in the opinion of the Circuit Court of Appeals as to no "new result" is, however, in no way controlling as to the conclusion which the court reaches. The court definitely found (R. 372) that the structure of the Wittenberg patent was anticipated by the prior art and invalid thereover. Consequently, the exact meaning which the court intended to confer upon the words "new result" is a moot question in this instance.

II.

The second reason relied on by the petitioner for the allowance of the petition for writ of certiorari is based on an argument that the Circuit Court of Appeals has not followed the provisions of Rule 52(a) of the Rules of Civil Procedure. A portion of this rule quoted by petitioner in its brief is as follows:

> "* * * Findings of fact shall not be set aside unless clearly erroneous, *and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses* * * *."

This quotation from the rule is correct, but due regard must be given to that portion of that quotation which has been emphasized in italics above. In the present case, there is no question whatever of the credibility of any witness. The court's decision does not turn on testimony of witnesses, but on the consideration of the legal effect of the prior art. This prior art includes both that cited by the Patent Office during the prosecution of the Wittenberg patent and other earlier references introduced before the court by the defendant.

The petitioner's position appears to be, in brief, that, first, the question of validity is a question of fact and, second, that the appellate court cannot reverse a finding of validity as a fact if there is any evidence whatever to support such a finding. While the question as to whether validity is properly a finding of fact or a conclusion of law is apparently somewhat confused in the published decisions, it is obvious that a holding of validity is subject to review by an appellate tribunal and subject to reversal. It is unnecessary to cite the large number of cases in which Circuit Courts of Appeals have reviewed decisions of District Courts and reversed findings of such courts as

to validity. It is equally true that this court, in a substantial number of its decisions in patent cases, has reversed findings of lower tribunals holding patents valid, and has held them invalid. It certainly cannot be argued that in all such cases there was no basis whatever for the finding of the lower tribunal or tribunals.

To go back to the question as to whether validity is properly a finding of fact or a conclusion of law, it is desired to point out that the decisions cited by the petitioner on pages 9 and 10 of its brief as supporting the finding of fact theory do not, in fact, support that theory. The first decision referred to is that in *Dooley* v. *Pease,* 180 U. S. 126. That is not a patent case. It was a case based on the ownership of personal property. It held that the findings of fact by the trial court were conclusive in courts of review. This related to actual facts and not to opinions or conclusions drawn from the facts. The court held that the facts stated in the findings were evidentiary only, but they were sufficient to support the finding of the ultimate fact.

The second case cited, that of *Lavender* v. *Kurn,* 327 U. S. 645, also was not a patent case. It related to a claim for damages of a brakeman who might have been accidentally killed in a railroad yard. This case was tried by a jury, and the jury had a chance to observe the witnesses and decide as to their credibility. That is directly contrary to the present situation where there was no jury and no question of credibility of witnesses. In the decision, the court stated, pages 652-53, as follows:

> "* * * Under these circumstances it would be an undue invasion of the jury's historic function for an appellate court to weigh the conflicting evidence, judge the credibility of witnesses and arrive at a conclusion opposite from the one reached by the jury."

The next decision is that of *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364. This was a patent case. The validity of certain claims of a patent on heel-lasting machines was sustained. The court, on page 365, stated:

> "• • • In pressing us to grant the writ, the petitioner insisted that it desired no retrial of the facts but merely a proper application of the law to the facts found by the courts below. We granted the writ."

In the present case that is exactly the action taken by the Circuit Court of Appeals for the Seventh Circuit. They properly applied the law to the facts as found by the court below. In the cited case there were concurrent findings of the District Court and the Circuit Court of Appeals that there were new combinations which produced an improved result. In this decision, this court held the finding of an improved result "was a finding of fact." Nevertheless, it did not merely affirm on the basis that there was supporting evidence. It reviewed the case to determine whether the factual "improved result" constituted patentable invention.

The next decision cited in Petitioner's Brief is that of *United States* v. *Esnault-Pelterie,* 299 U. S. 201. This was a decision of this court reviewing a decision in a patent case by the Court of Claims. It shows the position of this court as to the matter of validity being a conclusion of law rather than a finding of fact. On that point, the decision is directly contrary to the purpose for which it was apparently cited by the petitioner. The decision stated, on page 202:

> "• • • The record does not show whether at first the conclusion of law contained any statement as to validity or infringement."

Further, on page 203, it quotes further conclusions of law of the Court of Claims as follows:

> "* * * Upon the foregoing special findings of fact, which are made a part of the judgment herein, the court decides as a conclusion of law that the plaintiff's patent is valid and has been infringed by the United States and that he is entitled to compensation therefor under the act of June 25, 1910."

On page 206 there is a further pertinent statement. There this court stated:

> "* * * The failure of the lower court to make specific findings upon the main issues does not lay upon this court the duty of examining, analyzing and comparing the circumstantial facts found to ascertain whether as a matter of law they establish validity and infringement."

This same case was again before this court, and is reported in *United States* v. *Esnault-Pelterie,* 303 U. S. 26. There this court, by way of dicta, made the following statement:

> "* * * We are not unmindful of the rule that where, with all the evidence before the court, it appears that *no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structure and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art,* or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law." (p. 30, authorities cited)

While the above quoted statement was merely *dicta* so far as the case in which it appears is concerned, yet it affords a very reasonable reconciliation between decisions which have held that validity and infringement are questions of fact and those which have held them to be

questions of law. If the question of invention is determined by merely a comparison of the undisputed structures of the prior patents with that of the patent in suit, without requiring expert testimony and without presenting any disputed questions of fact, it would seem reasonable that a question of law is presented, and likewise the question of infringement is merely one of law, if it requires, as in the instant case, only a comparison of the plaintiff's patent with the accused device, as to the construction and operation of which there is no dispute.

At this point, on page 10 the petitioner's brief uses one of its numerous quotations of the words "we think" from the decision of the Circuit Court of Appeals. This use of those words, as well as their repeated use later in the brief, is absolutely misleading. The Circuit Court of Appeals for the Seventh Circuit definitely did not base its decision in this case on merely a "we think." What that court stated on page 9 of its decision (R. 372) is:

> "* * * It could be that the Examiner was wrong when he disallowed the claims and right when he allowed them. However, our study of the prior art in connection with the comments of the Examiner thereon leads us to the conclusion that his action in disallowing the claims was proper. And we are very definitely of the view that the patentability of these combination claims was not aided by the amendments responsible for their allowance."

This makes it very clear that the Circuit Court of Appeals carefully studied the prior art and were "very definitely" of the opinion that the claims were invalid.

On page 11 of petitioner's brief, the decision of the Circuit Court of Appeals for the Second Circuit in *Arnstein* v. *Porter,* 154 Fed. (2d) 464, is quoted. This, as stated, was a copyright case. The quotation in petition-

er's brief sets forth that the court believes its function is "to review" the "legal conclusions" in the decision of the District Court. It goes on to state that it is not a function of the Court of Appeals to determine whether it would have made the findings of fact, but merely whether they rest on sufficient evidence in the record. The decision has no apparent bearing upon the situation in the present case. There the appellate court reversed a decision of the District Court which dismissed the action on defendant's motion for summary judgment and returned the case for trial before a jury. The statements quoted by petitioner in its brief are mere dicta and were not pertinent to the decision of that case, nor do they have any bearing upon the decision of the present case.

The next case referred to on page 11 of petitioner's brief is that in *Lincoln Stores, Inc.* v. *Nashua Manufacturing Co.*, 157 F. (2d) 154. That case is interesting in that it was decided by a divided court. The majority opinion contains the quotation made by petitioner. This opinion also carried the statement that, while the matter as to whether the question of invention is one of fact or of law is not too clear on the authorities, the court would regard it as a question of fact. Judge Woodbury, dissenting, concurred in this holding as to invention being a question of fact but, nevertheless, considered the prior art set up by defendant and ruled that this prior art invalidated the patent. The decision of the majority of the court, also, did not merely hold that there was evidence supporting the District Court's findings, but thoroughly reviewed that evidence. Therefore, although it held the question of invention to be a question of fact, it did not hold, as petitioner would argue, that the facts could not be reviewed by the Court of Appeals. The Court of Appeals did not

merely state that the findings of the trial court were "supportable in view of the evidence."

The petitioner's brief then goes on to discuss further the present interpretation to be given to Rule 52 (a) of the Federal Rules of Civil Procedure. It cites some thirteen cases in which petitions for writs of certiorari on this point were passed upon by this court during the past term. It is important to note that in every instance the court denied the petitions. It is respectfully submitted that the same action should be taken in the present case. In this case, the Court of Appeals did not find as to facts any differently from the trial court. They went over the facts, however, and determined that, as a matter of law, these facts proved definitely that the subject matter of the patent did not involve invention.

Another decision of this court which bears on the question as to whether or not infringement or validity are questions of fact or of law is that in *Market St. Ry. Co.* v. *Rowley,* 155 U. S. 621, 625. Here this court, in considering whether the question of invention was one of law or of fact, made the following statement:

> "The defendant put in evidence a number of patents prior in date to the plaintiff's, and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff. No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to say what the invention described in each, and to affirm from such mere comparison whether the inventions were or were not the same. The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury."

In the present case, the facts are undisputed and the question of validity has equally resolved itself into one of law, in this case depending upon a comparison between the claims and structure disclosed on the face of the patent and the prior art patents before the court.

III.

The third and last point raised by petitioner is an allegation that the Circuit Court of Appeals drew improper conclusions from the Wittenberg file wrapper and that its holdings are in conflict with other Circuit Courts of Appeals. It is urged that this point is entirely without merit, as it is based upon an erroneous reading of the opinion of the Circuit Court of Appeals. The court went over the proceedings in the Patent Office, as shown by the file wrapper, which was of record in the case. It did not state that there was any "file wrapper estoppel." Its decision was based on no such holding.

What the court did do was to have the benefit of the interpretation of the references made by the Examiner. It then studied the references and in part agreed with the Examiner and in part disagreed with him. All that it said about the file history, by way of conclusion, was (R. 372):

> "In any event, the manner in which allowance of these claims was procured seriously impairs the presumption of validity which ordinarily attaches to the grant. Of course, the circumstances are not conclusive against validity but we think they are persuasive."

This is very far from holding that the proceedings in the Patent Office constituted an estoppel. The decision then goes on to state (R. 372):

> "It could be that the Examiner was wrong when he

disallowed the claims and right when he allowed them. However, our study of the prior art in connection with the comments of the Examiner thereon leads us to the conclusion that his action in disallowing the claims was proper."

This referred to the rejection of the claims by the Examiner on references, which rejection was made in the next to the last Office action. The decision then goes on to state (R. 372):

"And we are very definitely of the view that the patentability of these combination claims was not aided by the amendments responsible for their allowance."

Thus, the Circuit Court of Appeals agreed with the earlier position of the Examiner that the claims were invalid over the art cited. The examiner finally reversed himself after the filing of an amendment, adding certain limitations, and allowed the claims. The Circuit Court of Appeals, after considering the claims and the references, held that the Examiner was wrong in reversing himself and allowing the claims. The decision of the Circuit Court of Appeals, therefore, is based upon a thorough consideration of the prior art and not, in any sense, upon a "file wrapper estoppel."

The decision next states (R. 372):

"The patentee perfected a stream-lined apparatus which, as already shown, possessed numerous advantages over that which was old."

Thus, the Circuit Court of Appeals recognized and agreed with the findings of fact of the District Court as to the advantages of the patented structure. The Circuit Court of Appeals, however, did not agree with the conclusion of law drawn from those facts by the trial court. The Circuit Court of Appeals next stated (R. 372):

"We think, however, that such advantages must be

attributed to the skill of the art and not to invention. We hold, therefore, that claims 1, 2 and 6 are invalid for lack of invention."

The above quotations from the opinion of the Circuit Court of Appeals make it very clear that that opinion is based solely upon the careful consideration by that court of the prior art and a holding that, in spite of the advantages of the structure developed by the patentee, it did not amount to invention but merely to the skill to be expected of one in that art.

In view of the statements quoted above from the decision of the Circuit Court of Appeals, it appears clear that the question as to whether or not "file wrapper estoppel" has any bearing on the issue of validity is merely a moot question in the present case. It is unnecessary, therefore, to discuss in detail the various decisions cited by the petitioner in support of its position that a file wrapper estoppel is not available as a defense on the question of validity.

In passing, however, it may be pertinent to mention that the decision in *International Cellucotton Products Co.* v. *Sterilek Co., Inc.,* 94 F. (2d) 10, cited on page 16 of petitioner's brief, has additional statements which bear on the matter of a Circuit Court of Appeals reviewing the prior art and reversing the District Court as to the question of validity. The Court of Appeals in the Second Circuit in that case took exactly the same position as that taken by the Circuit Court of Appeals in the Seventh Circuit in the instant case. There the District Court held six patent claims valid and infringed and, in addition, held one claim not infringed without passing on the validity of the claim. The Circuit Court of Appeals carefully reviewed the prior art considered by the trial court and reversed that court, holding invalid the five claims which

the trial court held valid and infringed. They affirmed the District Court in holding one claim not infringed. In the present case, the Circuit Court of Appeals for the Seventh Circuit reversed the District Court which held claims 1 and 2 valid and infringed and, in this case also, reversed the District Court, which held claim 6 valid but not infringed. The Circuit Court of Appeals held claim 6 to be invalid, passing on the question of validity because of the fact that in this case there was a counterclaim for declaratory judgment.

CONCLUSION.

It is respectfully submitted that the petition for a writ of certiorari should be denied for the following reasons:

1. The case does not come within any of the classes of cases which this court holds subject to review.

2. The Circuit Court of Appeals did not apply a new requirement or hold in conflict with prior decisions of this court in holding the patented structure achieved no patentable new result.

3. The Circuit Court of Appeals did not depart from Rule 52 (a) of the Federal Rules of Civil Procedure in reviewing the prior art in a patent case where no question of the credibility of a witness was involved.

4. The Circuit Court of Appeals did not raise or consider any question of file wrapper estoppel as to validity of the patent, nor consider a rejected claim as itself prior art.

5. The Circuit Court of Appeals did carefully consider the prior art of record and determine and decide that the claims were unpatentable thereover, any advantages of the patented structure being attributable to the "skill of the art and not to invention." In view of this holding of the Circuit Court of Appeals, each of the points raised in the petition, is merely a moot question in the present case.

Respectfully submitted,

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